

ADMINISTRATIVE PANEL DECISION

Mountain Hardware, Inc. v. Web Commerce Communications Limited, Client Care

Case No. D2023-1630

1. The Parties

The Complainant is Mountain Hardware, Inc., United States of America (“US”), represented by Strategic IP Information Pte Ltd., Singapore.

The Respondent is Web Commerce Communications Limited, Client Care, Malaysia.

2. The Domain Names and Registrar

The disputed domain names, <mountainhardwareaustralia.com>, <mountainhardwarefrance.com>, <mountainhardwaremalaysia.com>, <mountainhardwarephilippines.com> and <mountainhardwaresingapore.com>, are registered with Alibaba.com Singapore E-Commerce Private Limited (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on April 14, 2023. On April 14, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain names. On April 17, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain names which differed from the named Respondent (Redacted for Privacy) and contact information in the Complaint. The Center sent an email communication to the Complainant on April 18, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on April 25, 2023.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on April 25, 2023. In accordance with the Rules, paragraph 5, the due date for Response was May 15, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on May 16, 2023.

The Center appointed David Stone as the sole panelist in this matter on May 24, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant is a wholly owned subsidiary of the Columbia Sportswear Company. Headquartered in the United States of America, the Complainant distributes its apparel, accessories and equipment for mountain sport athletes and enthusiasts through specialty sporting goods retailers. These retailers are based in the US and 58 other countries worldwide. The Complainant has been trading under the name Mountain Hardwear, Inc. since 1993.

The Complainant owns numerous trade marks, including the following (“the Marks”).

MOUNTAIN HARD WEAR: International registration number 1210104, registered on May 4, 2014 in international classes 18, 20, 22 and 25;



: United States registration number 1901764, registered on June 27, 1995 in international classes 20 and 22;



: United States registration number 2906335, registered on November 30, 2004 in national class 25; and

MOUNTAIN HARDWEAR: Canadian registration number TMA440609, registered on March 17, 1995 in international classes 25 and 28.

In addition, the Complainant is the owner of the domain name <mountainhardwear.com>.

The disputed domain names were registered on September 13, 2022 except for <mountainhardwearfrance.com>, which was registered on September 16, 2022.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain names are confusingly similar to the Marks. The disputed domain names differ from the textual elements of the Marks only in the addition of a geographic description. This does not distinguish the disputed domain names from the Complainant's trade marks, trade name or registered domain name. Consequently, consumers are likely to see the use of the geographic descriptions as a natural extension of the Marks.

Furthermore, the Complainant contends that the Respondent has no rights or legitimate interests in respect of the disputed domain names. The websites associated with the disputed domain names are advertising the Complainant's products at heavily discounted rates, using the Marks and copyrighted images taken from the Complainant's website. Notably, the Marks appear as branding both on the websites and in the product images even though the Respondent is not an authorised dealer or distributor of the Complainant's products. The Respondent's use of the Marks and blatant replication of the Complainant's website shows that it had knowledge of the Marks when it registered the disputed domain names, and hence attempted to rely on the Complainant's reputation/goodwill to sell such products.

The Complainant contends that the Respondent registered and is using the disputed domain names in bad faith. Given the use of the Marks by the Respondent, the Complainant submits that it is implausible that the Respondent would have chosen to register and use the disputed domain names without meaning to pass itself off as the Complainant. The Respondent's use of the disputed domain names to redirect to a website containing images of the Complainant's merchandise for sale at a significant discounted price is evidence of bad faith use.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

Paragraph 4(a) of the Policy sets out the three requirements that the Complainant must prove in order to succeed:

- (i) that the disputed domain names are identical or confusingly similar to a trade mark or service mark in which the Complainant has rights;
- (ii) that the Respondent has no rights or legitimate interests in respect of the disputed domain names; and
- (iii) that the disputed domain names have been registered and are being used in bad faith.

A. Identical or Confusingly Similar

On the evidence provided by the Complainant, the Panel is satisfied that the Complainant has rights in the Marks. In assessing the similarity between the disputed domain names and the Marks, it is permissible to ignore the generic Top Level domain. The disputed domain names then comprise the textual elements of the Marks in addition to a geographic description. Where a trade mark is recognisable within a disputed domain name, the additional presence of a other terms does not prevent a finding of confusing similarity (WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)"), section 1.8). As contended by the Complainant, the addition of the geographical descriptions therefore does not prevent the confusing similarity between the disputed domain names and the Marks. The Panel finds that the disputed domain names are confusingly similar to the Marks, and concludes that the condition in paragraph 4(a)(i) of the Policy is satisfied.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy sets out the criteria that determine whether a domain name registrant has rights or legitimate interests in a domain name:

- (i) before any notice to the respondent of the dispute, the respondent's use of, or demonstrable preparations to use, the disputed domain name or a name corresponding to the disputed domain name in connection with a *bona fide* offering of goods or services; or
- (ii) the respondent (as an individual, business or other organisation) has been commonly known by the disputed domain name, even if the respondent has acquired no trade mark or service mark rights; or
- (iii) the respondent is making a legitimate noncommercial or fair use of the disputed domain name, without intent for commercial gain misleadingly to divert consumers or to tarnish the trade mark or service mark at issue.

The Complainant makes out a *prima facie* case that the Respondent has no rights or legitimate interests in the disputed domain names, and the Respondent has provided no evidence to contradict it.

On the facts and contentions before the Panel, the Respondent is not commonly known by any of the disputed domain names and is not duly authorised to use the Marks. Comparison of screenshots of the Respondent's website and the Complainant's website satisfies the Panel that the Respondent uses its websites to advertise the Complainant's products, or goods purporting to be the Complainant's products. It does so using the Marks.

The Panel finds that the Respondent is exploiting the confusing similarity between the disputed domain names and the Marks to divert Internet users searching for the Complainant's products and to deceive those users as to the origin of the advertised products. Such use of the Complainant's goodwill cannot constitute *bona fide* or legitimate fair use of the disputed domain names (*Atelier De Production Et De Création (A.P.C.) v. Linyi Wong*, WIPO Case No. [D2019-1931](#)). The condition in paragraph 4(a)(ii) of the Policy is therefore satisfied.

C. Registered and Used in Bad Faith

Paragraph 4(b) of the Policy sets out the non-exhaustive criteria for bad faith. Generally, for the purposes of the Policy, bad faith constitutes registration and use of a domain name in order to:

- (i) sell, rent or transfer the domain name to the trade mark owner (or a competitor thereof) for a profit;
- (ii) prevent the trade mark owner from registering its trade mark in a domain name, provided that the respondent is engaged in a pattern of such conduct;
- (iii) disrupt the business of a competitor; or
- (iv) divert Internet traffic for commercial gain.

The Complainant has provided evidence that the Respondent utilises the disputed domain names without its authorisation. The websites at the disputed domain names display branding identical to the Marks. This demonstrates that the Respondent was aware of the Complainant and its business prior to the dispute. As the Respondent has provided no explanation for its behavior, the Panel concludes that the Respondent registered the disputed domain names to create a misleading impression of association between the disputed domain names and the Complainant.

It is established that the registration of domain names which incorporate a well-known mark by an entity that has no relationship to the mark is evidence of bad faith (*Daimler Chrysler Corporation v. Web4COMM SRL Romania*, WIPO Case No. [DRO2006-0003](#)).

The Respondent's objective appears to be to divert Internet traffic for the Respondent's commercial gain, either through the sale of possible counterfeit products or to disrupt the Complainant's business by attracting Internet users to an unauthorised website from which they may purchase products. In either case, the Panel is satisfied that the Respondent knew of the Complainant and its business, and intentionally registered the disputed domain names in forms confusingly similar to the Marks.

The Panel can conceive of no other plausible explanation for the Respondent's behaviour, which falls within paragraph 4(b)(iv) of the Policy. The condition in paragraph 4(a)(iii) of the Policy is therefore satisfied.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain names, <mountainhardwearaustralia.com>, <mountainhardwearfrance.com>, <mountainhardwewearmalaysia.com>, <mountainhardwearphilippines.com> and <mountainhardwearsingapore.com>, be transferred to the Complainant.

/David Stone/

David Stone

Sole Panelist

Date: June 7, 2023